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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,931	06/26/2003	Graham Mensa-Wilmot	05516.084002	3848
7590 03/20/2006			EXAMINER	
Jonathan P. Osha Osha Novak & May L.L.P. Suite 2800 1221 McKinney Street Houston, TX 77010			PAYER, HWEI SIU CHOU	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,931

Applicant(s)

MENZA-WILMOT ET AL.

Examiner

Hwei-Siu C. Payer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

The amendment filed on 12-27-2005 has been entered.

Objection to the Specification

The disclosure is objected to because of the following informality: On page 1, line 6, after "filed October 26, 2000", --now U.S. Patent No. 6,823,952-- should be added.

Appropriate correction is required.

Claims Rejection - 35 U.S.C. 112, first paragraph (new matter)

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-4 and 12-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed "heating" step has no support from the specification as originally filed.

Claims Rejection - 35 U.S.C. 112, second paragraph

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4 and 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) In claim 1, lines 17-18, it is not understood how the mounting pad is formed from the inserted displacement.

(2) In claim 1, line 19, it is not clear how the relief groove is formed.

(3) In claim 1, lines 19-20, "positioned under the diamond table of the cutting element when the cutting element is mounted on the pad" is confusing. It is not clear what this claim language encompasses, and how this claim limitation defines any method step of forming a drill bit body.

(4) In claim 1, lines 20-26 are vague and indefinite. Exactly what method steps are defined by the "wherein" clauses?

(5) Claims 2-4 and 13-14 are vague and indefinite. It is not clear what method steps of forming a drill bit body are being claimed therein.

(6) In claim 12, line 15, it is not clear how the mounting pad is formed.

(7) In claim 12, line 17, it is not understood how the relief groove is formed.

(8) In claim 12, lines 17-18, "positioned under the diamond table of the cutting element when the cutting element is mounted on the pad" is confusing. It is not clear

what this claim language encompasses, and how this claim limitation defines any method step of forming a drill bit body.

(9) In claim 12, lines 19-20 are vague and indefinite. Exactly what method step is defined by the "wherein" clause?

Prior Art Citations

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Barr, Tibbitts et al., Weaver, Chow et al., Oldham et al. and Azar are cited as art of interest.

Remarks

Applicant's arguments with respect to claims 1-4 and 12-14 have been considered but are moot in view of the new ground(s) of rejection.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hwei-Siu C. Payer whose telephone number is 571-272-4511. The examiner can normally be reached on Monday through Friday, 7:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone numbers

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for the organization where this application or proceeding is assigned are 571-273-8300

for official communications and 571-273-4511 for proposed amendments.

H Payer
March 16, 2006

10-P Payer

**Hwai-Siu Payer
Primary Examiner**